

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 10/609,238
Filing Date 6/27/2003
Confirmation No. 7738
5 Applicant Microsoft Corporation
Inventorship..... Jean D. Paoli
Group Art Unit 2174
Examiner Nguyen, Le
Attorney's Docket No.MS-301662.01 (was MS-1407US)
10 Title: Markup Language Editing with an Electronic Form

RESPONSE TO RESTRICTION REQUIREMENT DATED 6/29/2007

15 To: Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

20 From: Michael K. Colby (Tel. 509-755-7262; Fax 509-755-7252)
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25 This responds to a Restriction Requirement dated June 29th, 2007.

Election/Restrictions

The Office subjected the claims to a restriction requirement under 35 U.S.C. § 121. The Office asserted that the claims contain seven distinct inventions that each require a different search:

- 5 I. Claims 1-14 and 63-65, drawn to context sensitive help, classified in class 715, subclass 708.
- 10 II. Claims 15-22 and 51-56, drawn to a topology, classified in class 715, subclass 734.
- 15 III. Claims 23-39, drawn to a mark up language interface, classified in class 715, subclass 760.
- 20 IV. Claims 40-50, 57-59 and 60-62, drawn to a GUI builder, classified in class 715, subclass 762.
- 25 V. Claims 66-68 and 73-75, drawn to environment customization based on stored profile, classified in class 715, subclass 745.
- 30 VI. Claims 69-72, drawn to real time data, classified in class 715, subclass 756.
- 35 VII. Claims 76-83, drawn to, drawn to end user based preference setting, classified in class 715, subclass 747.

20 Applicant hereby elects, **with traverse**, to prosecute Invention Group I (Claims 1-14 and 63-65) in the event that the restriction requirement is maintained. Applicant elects with traverse because the restriction requirement is improper and should be withdrawn. Applicant enumerates reasons that the restriction requirement is improper below. Any one of these reasons is sufficient to demonstrate that the requirement should be withdrawn.

No Prima Facie Showing of a “Serious Burden”

The Office must show that examining any two of these groups would be a serious burden on the Examiner. MPEP §803 states:

- 5 If the search and examination of all the claims in an application can be made without serious burden, the examiner **must** examine them on the merits, *even though they include claims to independent or distinct inventions.* (Emphasis added).
- 10 But the Office provides insufficient evidence to show that examining these groups would be a serious burden on the Examiner. The Office breaks claims 1-83 into seven groups, all of which are in the same class. Rather than show that each group would be difficult to examine with any other group, the Office provided contrary evidence. The Office instead indicated that all 83 claims can be
15 searched in a single class, namely class 715. Consequently, the Office has not made a *prima facie* case for restricting the claims to these seven groups.

Increased Burden on the Office

Processing one application will require less time for the Office to properly
20 examine, process, issue, and manage than seven applications. Many of the burdens that the Office bears in handling an application—especially administrative burdens—will be multiplied if this restriction is maintained. Withdrawing the restriction requirement and keeping the claims together in one application can prove more efficient and effective for the Office.

Increased Burden on the Applicant

10 Imposing a restriction requirement is unduly burdensome to Applicant. Applicant is forced to present a response here, and if the requirement is upheld, file and prosecute six separate applications on the merits. This results in a substantial financial burden on the Applicant for claims that can be handled effectively in one application.

Conclusion

10 Applicant respectfully requests that the Office withdraw its restriction requirements.

Respectfully Submitted,

Dated: 30 July 2007

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